REMARKS

In response to the Office Action dated April 13, 2006, claim 1 has been amended, and new claims 11-17 have been added. No new matter has been added. Reexamination and reconsideration of the claims as requested is respectfully requested.

In paragraph 2 on page 3 of the Office Action, claims 1, 2 and 6-9 are rejected under 35 U.S.C. § 112 first paragraph because the specification, while being enabling for use of the Flow-Thru Chip, does not reasonably provide enablement for any other analysis chip configuration. The Examiner has indicated that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The Applicants respectfully traverse this rejection, but have amended the application to overcome the objections. It is believed that all claims comply with 35 U.S.C.§ 112.

More specifically, in the *Response to Arguments* item 1 on pages 2-3 of the Office Action, the Examiner has stated that:

> ...applicant asserts, "the Flow-Thru Chip is referred to by Applicant as an exemplary embodiment only and therefore Applicant is fully entitled to any equivalent structures within the meaning of its claims. ".... However, the examiner has reviewed the specification and has not found a statement which states the analysis chip may be any equivalent structure to that of the Flow-Thru Chip. While the applicant may intend for the Flow-Thru Chip to be an exemplary embodiment, no other embodiments or analysis chips configurations are given in the specification. It is clear that not just <u>any</u> analysis chip will function within the device as claimed. .... If applicant insists on maintaining the same position, the examiner hereby invites applicant to point out the location as well as provide the specific passage which states the analysis chip can be any equivalent structure to that of the Flow-Thru Chip.

The description of the instant application, as published on June 20, 2002, states:

> [0015] Furthermore, ***[2] describes*** a so-called Flow-Thru Chip.TM., by means of which analysis of the analyte with respect to the existence of biological material in the analyte is performed.
>
> [0114] A. Steel, et al., The Flow-Thru Chip: A Three-Dimensional Biochip Platform, Microarray Biochip Technology, edited by M. Schena, pp 87-117, 2000;

(Emphasis added)

In paragraphs 0015 and 0114 of the description, the Flow-Thru Chip^{TM} is clearly identified as a prior art device, and therefore is not *per se* the invention of the present application.

Furthermore, the description of the instant application, as published on June 20, 2002, states:

> [0016] The Flow-Thru Chip.TM., which is ***a*** confirmation of an analysis chip, has a plurality of channels through which the analyte is fed through the analysis chip, the surface of the channels being provided respectively with probe molecules, generally with molecules which can bind, preferably covalently, the correspondingly targeted biological material whose existence in the analyte is to be detected.
>
> [0027] In this way, the analytes can be sucked using a very simple arrangement, in particular a significantly reduced number of pumps compared with the number of wells, for the case in which an analysis chip, ***for example*** the Flow-Thru Chip.TM. described in [2] with probe molecules applied to the surfaces of the liquid channels, is provided in the suction path, i.e. in the liquid channel inside the pipette, to simultaneously analyse several analytes, which are usually different.
>
> (Emphasis added)

Paragraphs 0016 and 0027 of the description make it clear that the Flow-Thru Chip^{TM} is just a configuration or an example of an (commercially available) analysis

chip, which is already part of the prior art, that may be used in the present invention. This also implies that the instant invention would work also with analysis chips other than Flow-Thru Chip™.

A "generic" description of analysis chips for usage in the present invention is found, for example, in the description at:

> [0030] Analysis chips are furthermore provided for analyzing the analyte, one analysis chip being in each case assigned to a well in order to analyse an analyte introduced into the respective well. The surface of at least a part of the analysis chips, which surface comes into contact with the analyte, is designed in such a way that biological material for binding molecules contained in the analyte can be fixed on the surface.

The only descript difference between the "generic" description of the "generic" analysis chip and the description of the Flow-Thru Chip™ in the instant application is that the Flow-Thru Chip™ has a plurality of channels through which the analyte passes and contacts the probe material.

Notwithstanding, one skilled in the art could reasonably draw the inferences that the present invention would equally work with a "generic" or different analysis chip, other than the mentioned Flow-Thru Chip™, which also has a plurality of channels through which the analyte can pass and which contain the probe material. There is no hint or suggestion in the application that the present invention is limited to the Flow-Thru Chip™ even when using analysis chip which have a plurality of channels through which the analyte can pass and which contain the probe material.

The Examiner made no prior art rejection in the Office Action.

It is therefore believed that the claims meet the requirements of 35 U.S.C. § 112, first paragraph. Claim 1 has been slightly amended to clarify the claim.

The amendments to claim 1 are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In view of the foregoing, reconsideration and allowance of claims 1, 2, 6-9 and 11-17 are solicited.

CONCLUSION

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. The amendments clarify the patentable invention without adding new subject matter. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Jeffrey R. Stone at 952 253-4130.

Respectfully submitted,

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